

REMARKS

Applicants submit this Reply in response to the final Office Action mailed July 24, 2008. Before this Reply, claims 17-35 were pending, of which claim 17 is the only independent claim. In the final Office Action, the Examiner rejected claims 17, 20, 21, and 31-34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,456,847 ("Lilja et al."). The Examiner rejected claims 18, 22-31, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Lilja et al. in view of U.S. Patent No. 6,940,827 ("Li et al."). The Examiner also rejected claims 17 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0009998 ("Reemtsma") in view of Lilja et al. Finally, the Examiner rejected claims 18-31 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Reemtsma in view of Lilja et al. and further in view of Li et al.

In this Reply, Applicants have amended independent claim 17 and added new claims 36-38 to round out the protection of the invention to which they are entitled. Applicants have canceled dependent claim 18 without prejudice or disclaimer. As a result of these amendments, claims 17 and 19-38 are currently pending, of which claims 17 and 36 are independent. Applicants respectfully traverse the pending claim rejections and request reconsideration of the application, as presently amended.

Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the Section 102(e) rejections of claims 17, 20, 21, and 31-34. In order to properly establish an anticipation rejection under 35 U.S.C. § 102(e), every element of the claims at issue must be found in the applied prior-art reference, either expressly or under principles of inherency. Furthermore, "[t]he

identical invention must be shown in as complete detail as is contained in the ... claim.”

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In this case, Lilja et al. fails to teach or suggest every element of Applicants’ invention.

Independent claim 17, as amended, calls for a combination including, for example, “a type of radio access used by at least one base radio station providing the packet data transmission service in the at least one macrocell is updated to support the multi-carrier radio access used in the at least one microcell.” Independent claim 36 similarly recites, among other things, “updating at least one base radio station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access.”

The Examiner acknowledges that Lilja et al. fails to teach or suggest at least the “multi-carrier radio access” recited in independent claims 17 and 36 and thus required by their dependent claims 18-35 and 37-38. Specifically, the Examiner stated that “Lilja ‘847 . . . [is] silent with respect to claimed features: . . . the packet data transmission service by using a multi-carrier radio access.” Final Office Action dated July 24, 2008, at 9. Indeed, rather than using a multi-carrier radio access, Lilja et al. specifically “relates to a cellular radio system which utilizes the WCDMA method.” Lilja et al., col. 2, ll. 46-47. Accordingly, there is no dispute that Lilja et al. fails to teach or suggest every element of Applicants’ invention as required for a proper rejection under Section 102(e), for at least the reason that Applicants’ claimed “multi-carrier radio access” is absent from the radio system in Lilja et al.

Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Section 103(a) rejections of pending claims 17-35. To establish a *prima facie* case of obviousness, “All Claim Limitations Must Be Considered.” M.P.E.P. § 2143.03 (8th ed., rev. 6, Sept. 2007). More specifically, the M.P.E.P. requires that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *Id.* (quoting In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970)).

In the final Office Action, the Examiner noted that Lilja et al. and Reemtsma fail to disclose “a multi-carrier radio access,” as recited in Applicants’ amended independent claims 17 and 36. See final Office Action dated July 24, 2008, at 20 (“Reemtsma ‘998 and Lilja ‘847 disclose all the claimed limitation with the exception of being silent respect to the claimed features: . . . the packet data transmission service by using a multi-carrier radio access”). Therefore, neither Lilja et al. nor Reemtsma discloses or suggests at least “a type of radio access used by at least one base radio station . . . is updated to support the multi-carrier radio access used in the at least one microcell,” as recited in independent claim 17, or “updating at least one base radio station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access,” as recited in independent claim 36.

Applicants submit that Li et al. does not cure the above-noted deficiencies in Lilja et al. and Reemtsma. Li et al. discloses a communication system for “transmitting orthogonal frequency division multiplexing (OFDM) signals to the subscriber, and receiving direct-sequence spread spectrum (DSSS) signals from the subscriber.” See, e.g., Li et al., col. 2, ll. 45-50; Abstract. In a first embodiment (FIG. 3), Li et al. discloses

a system where OFDM radio access is used in the downlink direction, i.e., from the network to the subscriber unit, and CDMA radio access (i.e., DSSS signals) is used in the uplink direction, i.e., from the subscriber unit to the network. See, e.g., Li et al., col. 6, ll. 3-8. In an alternative embodiment (FIG. 11), the network and subscriber unit are configured to communicate over uplink and downlink CDMA channels and over an additional OFDM downlink channel that enhances the downlink data rate. See, e.g., Li et al., col. 10, ll. 36-39.

Regardless of which embodiment is used in Li et al., the type of radio access over the uplink and downlink channels is predetermined and is not updated from one type of radio access to another. The network and subscriber units in Li et al. comprise transmitters and receivers that are configured to communicate over predetermined types of radio access channels, i.e., OFDM or CDMA channels, in the uplink and downlink directions. See, e.g., Li et al., FIGS. 3 and 11; col. 5, l. 59 – col. 6, l. 8; col. 10, ll. 41-47. These preconfigured OFDM and CDMA transmitters and receivers in Li et al. are coupled to a common “switch/duplexer” that allows their antennas to be used for both transmission and reception simultaneously. See, e.g., Li et al., col. 5, ll. 65-67. The switches/duplexers in Li et al. do not update or otherwise affect the predetermined types of OFDM and CDMA radio access used by the network and subscriber units.

In sharp contrast with Li et al.'s predetermined types of radio access that are never updated, Applicants' independent claim 17, as presently amended, recites, for example, “a type of radio access used by at least one base radio station . . . is updated to support the multi-carrier radio access used in the at least one microcell.” Similarly, Applicants' independent claim 36 recites, for example, “updating at least one base radio

station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access.”

Because Li et al. fails to disclose or suggest updating a type of radio access, as claimed, Li et al. does not cure this same deficiency in Lilja et al. and Reemtsma, whether these cited references are considered alone or in any reasonable combination. For at least this reason, Applicants submit that independent claims 17 and 36, as amended, are allowable over the art of record. Dependent claims 19-35 and 37-38 depend on independent claims 17 and 36 and are therefore allowable for at least the same reasons.

Conclusion

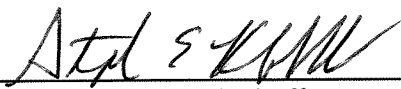
The preceding remarks are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of the application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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